

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MASAHIRO WATANABE  
and NORIAKI HARA

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Appeal No. 95-3869  
Application 08/037,301<sup>1</sup>

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ON BRIEF

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Before Ronald H. Smith, Kimlin and Metz, Administrative Patent Judges.

Ronald H. Smith, Administrative Patent Judge.

DECISION ON APPEAL

September 18, 1997, we mailed a decision on this appeal in which we held that appealed claims 1-5 would have been prima facie obvious to one of ordinary skill in the art (Paper No. 16).

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<sup>1</sup> Application for patent filed March 26, 1993.

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We remanded the case to the examiner to determine whether or not the objective evidence contained in the comparative examples is sufficient to rebut the prima facie case of obviousness. On October 14, 1997, the examiner issued a supplemental examiner's answer (Paper No. 17) addressing the objective evidence contained in the comparative examples. After carefully considering the examiner's position with respect to the evidence relied on by appellants, we have decided to reverse the rejection because we find the evidence of unexpected advantages to be sufficient to rebut the prima facie case of obviousness.

As pointed out by appellants in their brief, the process of the appealed claims, which call for powder coating and heat treating prior to fluorinating the polymer, results in unexpected improvement in reducing agglomeration and increasing porosity compared to the prior art process of solution or suspension coating. In the comparative examples appellants present six Examples (1-6) of powder coating according to the appealed claims and two comparative examples using the prior art solution or suspension coating process. The results set forth in Tables 1 and 2 show a substantial reduction in agglomeration for Examples

1-6 as compared to the comparative examples as well as a substantial increase in pore volume for Examples 1-6 as compared to comparative examples.

The examiner makes three points in his analysis of the comparative results. First, the examiner contends that "the comparative examples do not specifically disclose the amount of carbon black." We disagree. Example 1 sets forth the coating procedure that starts with 30 g. of carbon black. All of the following examples, including Examples 2-6 and comparative Examples 1 and 2, indicate that the procedure of Example 1 was followed with certain indicated exceptions. Thus, we believe 30 g. of carbon black are used in all of the examples including the comparative examples, and that the application fairly discloses that 30 g. of carbon black are used in comparative examples 1 and 2.

Secondly, the examiner urges that the comparative examples recite a heat treating temperature considerably higher than that of the examples of the appellants' invention. Again, we disagree with the examiner's position. Heat treating of the powdered coating composition is a claimed feature of the appealed claims, and the examples according to the claimed invention, i.e., Examples 1-6, include a heat treating of the powder coating

composition. However, the prior art solution or suspension coating process does not include a heat treatment of the coated particles. Accordingly, comparative Example 1 does not contain a heat treatment of the coated particle, contrary to the examiner's contention. The heating in comparative Example 1 is not a heat treating of the coated particle, but is a heating of the dispersion of the polymer in hexane prior to the coating of the carbon black particles.

Thirdly, the examiner urges that the claims are not limited to specific heat treatment temperatures or amounts of carbon black, and are therefore not commensurate in scope with the results relied on. Again, we disagree with the examiner's position. Examples 1-6 include a broad range of ratios of carbon black to polymer and a variation of heat treatments. Moreover, the unexpected improvement in agglomeration and pore volume is obtained in all six examples. Accordingly, it is apparent that the examiner has presented no basis for concluding that the results are limited to a particular temperature or amount of carbon black.

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The decision of the examiner is reversed.

REVERSED

Ronald H. Smith	)	
Administrative Patent Judge	)	
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	)	
Edward C. Kimlin	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Andrew H. Metz	)	
Administrative Patent Judge	)	

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